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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)	
	10/587,991	FOXENLAND, ERAL	
Office Action Summary	Examiner	Art Unit	
	ROBERT R. RAINEY	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 September 2009</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-5,7-22,24-35 and 37-40</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5, 7-22, 24-35, and 37-40</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 July 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claims 1-5, 7-22, 24-35, and 37-40 under consideration.

Response to Arguments

1.   Applicant's arguments with respect to claims 1, 18, and 31 and their dependent

claims, 4-5, 7-17, 19-22, 24-30, 32-35, and 37-40, have been considered but are moot

in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 1, 18, and 31 and dependent claims 4-5, 7-17, 19-22, 24-30, 32-35, and

37-40 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written

description requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. As amended these claims require that "the control unit is configured

to continuously change the parameters of the user interface associated with the normal

operation of the device" or similar recitations. The requirement "to continuously change"

represents new matter. The disclosure does not describe a case in which a change of

game parameters triggers the user interface parameters to continuously change.

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.   Claims 31-35 and 37-40 rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Claim 31 claims "a game module loadable into a device ... configured: to

transmit ...; and to command ... ." The game module is only loadable into a

device, not necessarily loaded into a device, but how can it be "configured: to

transmit ...; and to command ... ." without being loaded into and running on the

device?

Claims 32-35 and 37-40 inherit the defect of claim 31.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 31-35 and 37-39 rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claims 31-35 and 37-39 fail to fall within a

statutory category of invention. It is directed to the program itself, not a process

occurring as a result of executing the program. The claims recites a program

(software),thus it is non-statutory under 35 USC 101..

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   **Claims 1-5, 7-22, 24-35, and 37-40** are rejected under 35 U.S.C. 103(a) as

being unpatentable over U.S. Patent Application Publication No. 2004/0157654 to

Kataoka et al. ("*Kataoka*") in view of U.S. Patent No. 6,336,865 to *Kinjo* ("*Kinjo*") and

further in view of U.S. Patent Application Publication No. 2004/0216054 to *Mathews et*

al. ("*Mathews*").

As to **claim 1**, *Kataoka* discloses a game apparatus and in particular:

a device, comprising:

a user interface, a control unit for controlling operations of the device

including changeable parameters of the user interface, and a game platform for

running a game (see for example [0037], especially "a mini-game for playing on a

portable phone or other such terminal apparatus"), wherein the control unit is

configured to ~~continuously~~ change the parameters of the user interface

associated with a normal operation of the device (see for example [0037],

especially "The gamers can use the game scores of the mini-game to obtain

melodies of incoming calls and wallpaper for portable phones" and [0040]

especially "wallpaper of characters appearing in the game") ~~whenever the user~~

~~interface parameters in the game change~~ based on events occurring in the game

(see for example [0037], especially "The gamers can use the game scores of the mini-game to obtain melodies of incoming calls and wallpaper for portable phones" in which game scores are events occurring in the game).

At [0024] *Kataoka* further teaches "changing the color of the character's outfit" in which the outfit color change is both a change in the user interface parameters of the game and an event occurring in the game.

Kataoka further teaches that that a theme may be associated with a game and used in a portable phone (see for example [0037]; note that in the particular embodiment the game is played on one device and the theme image is sent to a different device).

Kinjo discloses a game scene reproducing machine and game scene reproducing system and in particular:

a game system which allows the user to capture a changed game scene image whenever the user interface parameters in the game change based on events occurring in the game and to provide means for the user to save and display the image (see for example 1:16-30 especially "an operator (player) of a game inputs his or her desire for outputting a print of a game scene image through a button or a command disposed on a game machine at the time the game scene is displayed while the game is being executed. This information is recorded in a memory"; any change in the game UI must result from, i.e. be based on, events in the game); and that

certain game scenes, representing certain UI parameter changes, are particularly indicated for capture and display (see for example 7:1-29 especially "Examples of data to be added, i.e., either composite or attached, are: data of a certain letter and an image, "Congratulations!" for instance, designed to mark a moment when a player conquers a specific scene of a game in progress").

Kataoka and Kinjo are analogous art because they are from the same field of endeavor, which is computer games and seek to solve the same problem, which is to provide game-play incentives.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to improve the device of Kataoka by adding the capability to capture a changed game scene image whenever the user interface parameters in the game change based on events occurring in the game as taught by Kinjo and to allow the user to save and display the image according to the means taught by Kataoka, that is as wallpaper.

The suggestion/motivation would have been to provide advantages such as to provide a common feature (see for example Kinjo 1:15-20).

Kataoka and Kinjo does not explicitly disclose that the change of parameters of the user interface associated with a normal operation of the device occurs "continuously". For the purpose of examination, examiner assumes that what is meant is something like "normal operation UI parameters are automatically changed when certain game UI parameters change".

In the combination of *Kataoka* and *Kinjo* as presented it is reasonably suggested that a user would have certain criteria for UI parameter change sufficient to cause the user to create a new game scene wallpaper for the device, such as, for example, a change of color of a character's outfit or the conquering of a specific scene. That is, the user would choose to change the normal operation UI parameters when certain game UI parameters change; and thus normal operation UI parameters are changed when certain game UI parameters change. In the extreme, the user could of course perform a game scene image capture and wallpaper change continuously without regard to whether or not the scene had changed. In this case, although a new wallpaper image file would continually replace the old one, the normal UI would only change when the game scene changes because otherwise the new and old files would be the same; and thus, again in this case, normal operation UI parameters are changed when certain game UI parameters change.

Since it has been held that automating an operation does not require more than ordinary skill in the art as long as the operations are performed in the same manner and the same effect is achieved, it would have been obvious to improve the device of *Kataoka* and *Kinjo* such that normal operation UI parameters are automatically changed when certain game UI parameters change, that is such that normal operation UI parameters are continuously changed.

While the rejection to this point seems adequate, in order to further prosecution, examiner also combines *Mathews*, which explicitly teaches the automation of previously manual operations in a comparable product.

Mathews discloses a method and apparatus for modifying skin and theme screens on a communication product and in particular:

a control unit configured to continuously change parameters of the user interface based on various events (see for example [0010], especially "...steps at the portable communication device of determining if the event has occurred and if the event has an associated skin and theme, and if the associated skin and theme exists, updating the display with the associated skin and theme.", [0025] and Fig. 4); and

grouping the parameter changes according to themes according to entertainment products (see for example [0020] especially "Harry Potter theme" and "Disney theme").

Kataoka and *Kinjo* and *Mathews* are analogous art because they are from the same field of endeavor, which is portable communication devices, and seek to solve the same problem, which is to allow user customization of the device.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to improve the device of *Kataoka* and *Kinjo* by adding the capability to group the parameter changes according to themes according to entertainment products as taught by *Mathews*, which entertainment products in the context of the combination would include games (since this would provide an

incentive for game play, see for example *Kataoka* [0039]), and to manage the change of themes in a continuous manner according to the methods taught by *Mathews*.

The suggestion/motivation would have been to provide advantages such as to utilize known methods or to provide a number of different themes in a theme pack (see for example *Mathews* [0005]) or to provide an improvement – continuous, i.e. automatic, change of themes - which was known in the art to have been applied to a comparable product, since in Mathews the improvement was to automate UI changes which were previously performed or could have been performed by the user.

As to **claim 2**, the limitations that themes with changeable parameters are defined for the user interface and at least one of the themes is associated with the game were covered in the rejection of claim 1.

As to **claim 3**, in addition to the rejection of claim 2 over *Kataoka* and *Kinjo* and *Mathews,* the combination further includes different parameters of one of the themes being associated with different levels of the game since images saved according to game level was taught.

As to **claim 4**, in addition to the rejection of claim 2 over *Kataoka* and *Kinjo* and *Mathews,* the combination already taught changing the wallpaper with

each level, which means that a theme is associated with each level. To further

prosecution examiner also offers that the combination already taught theme

packs to facilitate automatic theme change and certainly the user could have

changed other theme parameters, i.e. toolbar color, to better match the changed

wallpaper, examiner is not persuaded that including a theme associated with

different game levels in order to automate the changeover of multiple theme

parameters would have required more than ordinary skill in the art either to

recognize as desirable or to implement.

As to **claim 5**, in addition to the rejection of claim 1 over *Kataoka* and

Kinjo and *Mathews,* the combination further includes that different parameters

are associated with different scores of the game since wallpaper available

according to game score was taught.

As to **claim 7**, in addition to the rejection of claim 1 over *Kataoka* and

Kinjo and *Mathews*, *Kataoka* and *Kinjo* and *Mathews* teach the claimed invention

except for the control unit being configured to change parameters of the user

interface when the game is interrupted. However, game interruption time would

have been one of several obvious times to update the UI, the others being

periodically, at the time of particular events, at user initiation. Game interruption

time would have been obvious at least because games on small screens

customarily use the entire screen and there would be no need to update the

device UI until the screen is relinquished by the game. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a control unit configured to change parameters of the user interface when the game is interrupted.

As to **claim 8**, in addition to the rejection of claim 7 over *Kataoka* and *Kinjo* and *Mathews*, *Mathews* further discloses that the control unit is configured to change parameters automatically upon event detection (see for example Fig. 4) making the combination configured to change parameters automatically when a user exits the game.

As to **claim 9**, in addition to the rejection of claim 7 over *Kataoka* and *Kinjo* and *Mathews*, *Mathews* further discloses that the control unit is configured to change parameters by a user command (see for example [0021] "...detection of a particular user input...").

As to **claim 10**, in addition to the rejection of claim 9 over *Kataoka* and *Kinjo* and *Mathews*, *Kataoka* and *Kinjo* and *Mathews* discloses the claimed invention except for the control unit being configured to be locked by a user command to stop future changes of the parameters of the user interface.

Examiner takes official notice that enabling and disabling auto-update features by the user was well known in the art at the time of the invention. For

example, *Mathews* at [0026] and Fig. 4 item 120 teaches locking out automatic

theme download. Thus configuring the control unit to be locked by a user

command to stop future changes of the parameters of the user interface would

have been obvious to one of ordinary skill in the art at the time of the invention.

As to **claim 11**, in addition to the rejection of claim 2 over *Kataoka* and

Kinjo and *Mathews*, *Kataoka* further discloses that the device is configured to

save a changed user interface theme in a format that may be transmitted with a

message to another device (see for example [0038] "The system may also be

designed such that wallpaper that authenticates the identity of a certified player is

transmitted to the digital portable phone of the certified player.").

As to **claim 12**, in addition to the rejection of claim 5 over *Kataoka* and

Kinjo and *Mathews*, *Kataoka* further discloses saving scores in a format that may

be transmitted to another device (see for example [0011] and [0030]-[0031] in

this case the sending device is a server). *Kataoka* and *Kinjo* and *Mathews*

discloses the claimed invention except for the user's device being the one that

saves the scores and that the scores are in a format that may be transmitted with

a message.

The previously cited teaching in *Kataoka* of receiving and displaying

wallpaper indicates that the device is capable of storing information. One of

ordinary skill could have implemented the storage in the device by known

methods and would have recognized that the result would be predictable. That is

that the scores would be stored locally. As to the scores being in a format that

may be transmitted with a message, since both text and image transmission was

known and both are customarily represented by digital memory sequences and

digital memory sequences are the things transmitted as messages the format is

one that may be transmitted with a message to another device.

As to **claim 13**, in addition to the rejection of claim 2 over *Kataoka* and

Kinjo and *Mathews*, *Mathews* further discloses that the theme includes a set of

picture settings comprising picture parameters such as colour, contrast, light

intensity; picture objects; animation effects and bitmap shapes; sound settings

comprising sound parameters; sound objects; vibration settings comprising

vibration parameters, said theme being associated with operations of the device

(see for example [0020]).

As to **claim 14**, in addition to the rejection of claim 1 over *Kataoka* and

Kinjo and *Mathews*, *Mathews* further discloses that the user interface comprises

a display for showing information related to the operations of the device by

means of a graphical interface of the display (see for example [0030]).

As to **claim 15**, in addition to the rejection of claim 14 over *Kataoka* and *Kinjo* and *Mathews*, *Mathews* further discloses that the user interface comprises a sound system (see for example [0003]).

As to **claim 16**, in addition to the rejection of claim 15 over *Kataoka* and *Kinjo* and *Mathews*, *Kataoka* and *Kinjo* and *Mathews* disclose the claimed invention except for the user interface comprising a vibration element.

Examiner takes official notice that both game and cell phone UIs with vibration elements were well known in the art at the time of the invention.

It would have been obvious to include a known feature, vibration, in the UI of *Kataoka* and *Kinjo* and *Mathews.*

As to **claim 17**, in addition to the rejection of claim 1 over *Kataoka* and *Kinjo* and *Mathews*, *Mathews* further discloses that the device is a portable telephone, a pager, a communicator, a smart phone, an electronic organiser, a calculator or a positioning device (see for example [0005] "smartphones").

The following claims are method claims representing methods implicit in the corresponding apparatus claims.

Claim 18 is rejected on the same grounds and arguments as claim 1.

Claim 19 is rejected on the same grounds and arguments as claim 2.

Claim 20 is rejected on the same grounds and arguments as claim 3.

Claim 21 is rejected on the same grounds and arguments as claim 4.

Claim 22 is rejected on the same grounds and arguments as claim 5.

Claim 24 is rejected on the same grounds and arguments as claim 7.

Claim 25 is rejected on the same grounds and arguments as claim 8.

Claim 26 is rejected on the same grounds and arguments as claim 9.

Claim 27 is rejected on the same grounds and arguments as claim 10.

Claim 28 is rejected on the same grounds and arguments as claim 11.

Claim 29 is rejected on the same grounds and arguments as claim 12.

Claim 30 is rejected on the same grounds and arguments as claim 13.

Claims 31-38 are claims to a "game module". The teaching by *Mathews* of

the capability to run a "generic application" (see for example Mathews Fig. 3 item

73) make it clear that such a software implementation of the functions was taught

or implicit in the corresponding apparatus rejections.

Claim 31 is rejected on the same grounds and arguments as claim 1.

Claim 32 is rejected on the same grounds and arguments as claim 2.

Claim 33 is rejected on the same grounds and arguments as claim 3.

Claim 34 is rejected on the same grounds and arguments as claim 4.

Claim 35 is rejected on the same grounds and arguments as claim 5.

Claim 37 is rejected on the same grounds and arguments as claim 7.

Claim 38 is rejected on the same grounds and arguments as claim 13.

Claim 39 is a claim to a computer program product loadable in a device and comprising computer readable program code for implementing a game module as defined in claim 31 and is rejected on the same grounds and arguments as claim 31.

As to claim 40, in addition to the rejection of claim 31 over *Mathews* and *Kataoka*, the teaching by *Mathews* of the capability to run a generic application (see for example Fig. 3 item 72) would have fairly implied to one of ordinary skill in the art that such an application would reside on a computer readable medium.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 7,032,229 to *Fiores et al.* teaches a method of monitoring game progress to allow the tracking of content, such as the level of a game to which a user advanced; see for example BSTX (6).

U.S. Patent Application Publication No. 2005/0287925 to *Proch et al.* teaches wallpaper for levels of game performance see for example [0260].

U.S. Patent Application Publication No. 20040121837 to *Chiang et al.* discloses events in a game triggering action, including UI changes, within a separate application, in *Chiang* the other application is a different game (see for example [0045] especially "For example, certain unlockables or passwords may

be provided to a user if a certain achievement has been achieved in another

game.").

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to ROBERT R. RAINEY whose telephone number is

(571)270-3313. The examiner can normally be reached on Monday through Friday 8:30

AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Amare Mengistu can be reached on (571) 272-7674. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RR/

/Amare Mengistu/
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